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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,074	11/19/2003	Richard J. Davies	DAVIES 3.0-001 CIP I	7252
530	7590	03/03/2006	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			MARMOR II, CHARLES ALAN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/717,074

Applicant(s)

DAVIES, RICHARD J.

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 13-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07192004; 08162004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of the invention of Group I, claims 1-12, in the reply filed on February 14, 2006 is acknowledged. Because applicant did not distinctly and specifically point out any errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 13-36 have been withdrawn from further consideration as being directed to a non-elected invention.

### ***Information Disclosure Statement***

2. The information disclosure statement filed July 19, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the Non Patent Literature Documents referred to therein have not been considered.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: the "overload sensor" as included in Figure 1; "441" as included in Figure 2; "460" as included in Figure 3; and "453" as included in Figure 5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any

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amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

4. The disclosure is objected to because of the following informalities: At paragraph [0096], line 19, "[502]" should read--[500]--. Appropriate correction is required.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

6. Claims 1, 6 and 10 are objected to because of the following informalities:

- a. At claim 1, line 7, "and" (second occurrence) should be deleted.
- b. At claim 6, line 14, "and" should be deleted.
- c. At claim 10, line 13, "the" should read --an--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirsch et al. ('935). Hirsch et al. teach an apparatus for determining the condition of a region of tissue. The apparatus includes a cup (10, 110) having an interior (12, 113) and first and second openings. An electrode (33) is disposed within the interior. A source of suction (24, 42) is connected to the second opening (22, 122). When the first opening is placed over a region of tissue and suction is applied to the second opening, an electrical connection is made between the region of tissue to be examined and the electrode. A flange (19, 119) surrounds the first opening. The source of suction is a syringe (see Figs. 9-11) or aspirator (24). A measuring device (63) communicates with the electrode to determine an electrical signal from the electrode and a display device may display the electrical signal from the electrode. Regarding claims 8 and 9, the Examiner respectfully submits that the characteristics of the tissue being examined by the device have no effect on the structure of the claimed apparatus. Therefore, since the apparatus of Hirsch et al. is capable of examining such tissue, the Hirsch et al. apparatus is deemed to read on claims 8 and 9.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch et al. ('935) in view of Lundback ('404). Hirsch et al., as described above, teach all of the limitations of the claims except that an electroconductive medium is provided to facilitate an electrical connection between the region of tissue to be examined and the electrode. Lundback teaches that it is known to apply electroconductive agents, such as conductive gel or physiological saline, to tissue in order to improve electrical contact between the skin and a biomedical electrode element (see column 1, lines 29-35). It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to use an electroconductive medium, such as saline solution, with an electrode apparatus similar to that of Hirsch et al. in light of the teachings of Lundback, in order to improve electrical contact between the skin and the electrode element.

11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch et al. ('935) in view of Dempsey et al. ('222). Hirsch et al., as described above, teach all of the limitations of the claims except that there are wireless connections between the measuring unit and the electrode and between the measuring device and the display device. Dempsey et al. teach the desirability of providing wireless connections between electrodes, processors and

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displays in order to allow monitoring of a patient wearing the electrode apparatus while enabling freedom of movement the patient wearing the apparatus at least within selected areas of the institution, where the patient is not encumbered by wires or conductive leads. It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to provide wireless connections between the electrodes, measuring unit and display of an apparatus similar to that of Hirsch et al. in light of the teachings of Dempsey et al, in order to allow monitoring of a patient wearing the electrode apparatus while enabling freedom of movement the patient wearing the apparatus at least within selected areas of the institution, where the patient is not encumbered by wires or conductive leads.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adelman et al. ('604) teach apparatus for manipulation of organ tissue, where the apparatus may include an electrode. Sharrow et al. ('418) teach apparatus for delivery of agents to the female reproductive tract, where the apparatus may include an electrode. Sartorius ('801) and Covington ('660) teach apparatus including nipple cups. Svedman ('044) teach a device for sensing bioelectrical signals. Samson ('865) teaches a non-invasive medical probe.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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February 23, 2006